

### REMARKS

Originally filed Claims 1 - 27 and newly filed Claims 28 - 40 are pending. Applicant requests reconsideration of the application in light of the following amendments and remarks.

In the outstanding office action, the Examiner objected to claims 5, 13, 14 and 21 as being dependent on a rejected base claim, but allowable if rewritten in independent form. As such, claims 5, 13, 14 and 21 have been amended and are now in condition for allowance. New claims 28 - 40 depend from the various allowable claims and present further patentable embodiments of the present invention.

Favorable reconsideration is respectfully requested in light of the following remarks. Applicants request withdrawal of the outstanding rejection and allowance of the claims.

#### Rejection under 35 U.S.C. §103(a)

In the outstanding office action, the Examiner rejected claims 1- 4, 6 - 12, 15 - 20 and 22 - 27 under 35 U.S.C. §103(a) over the Diamond U.S. Patent No. 4,148,168 (hereinafter, "Diamond") in view of the King et al. U.S. Patent No. 6,220,329 (hereinafter, "King et al.") references. Applicant contends that all the claims are patentable over these references, and requests withdrawal of the rejection under 35 U.S.C. §103.

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. The mere fact that references can be

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP §2143.

The Examiner admits that the Diamond reference "lacks the starter shingle of the course of starter shingles." The Examiner also admits that the Diamond reference also "lacks the starter shingle including an exposed portion extending between tabs of the covering shingles."

With respect to the first criterion, there is no motivation to modify the Diamond reference with the covering shingle of the King et al. reference to meet the claimed invention. The King et al. describes multilayer covering shingles only.

There is no teaching or suggestion in the King et al. reference of any starter shingle or any suggestion to use of a row of starter shingles beneath the covering shingles. The figures 6, 7, 10b and 11b in the King et al. reference, relied upon by the Examiner, show a multiple layer covering shingle. The King et al. reference, at column 15, lines 48 - 67, describes a shingle 120 having a third, "bottom layer 126". Also, as clearly shown in the King et al. figures 6 and 7, the bottom layer 126 is part of a three-layer laminated shingle 120. Further, the King et al. reference, at column 16, lines 1 - 9 generally describes installing the shingles on a roof. There is no suggestion that two types of shingles are used in either the Diamond or King et al. references.

In contrast, the present invention provides a starter shingle useful for covering a roof deck by first laying a course of starter shingles and then laying sequential courses of covering shingles over the first course of starter shingles. As best seen in Fig. 5 of the instant application, the laminated starter shingle allows the subsequent layers of the covering shingles to be placed on the roof

without causing an undesirable bump in the roof as the covering layers are added onto the roof.

Also, neither the Diamond nor King et al. references addresses the installation issue solved by the present invention. The present inventive laminated starter shingle provides a roof installer with the ability to cover a roof deck without requiring the roof installer to expend undesirable time and effort in "fabricating" starter shingles at the job site. The King et al. reference teaches away from the present invention by showing only one type of multilayer covering shingle to be used on the entire roof.

Therefore, the independent Claims 1, 11 and 18, which describe two types of shingles (a laminated starter shingle and a covering shingle), are patentable over the Diamond reference, either alone or in combination with the King et al. reference. Since independent claims 1, 11 and 18 have been shown to be patentable over applied references, for at least for this reason, claims 2 - 4, 6 - 12, 15 - 16, 19 - 20, and 22 - 27 are also patentable over those references.

For at least for these reasons the cited reference fails to teach or suggest the invention defined in the claims. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. §103.

#### Conclusion

None of the cited references teaches or suggests a laminated starter shingle having an underlay sheet laminated below an overlay sheet. Further, none of the cited references teaches or suggests covering a roof deck where a plurality of successive generally horizontal courses of covering shingles are laid above a plurality of laminated starter shingles. Rather, the cited references fail to suggest the present invention by failing to describe such features.

Claims 5, 13, 14 and 21 have been amended to be in independent form and are now in condition for allowance. The newly added claims 28 - 44 variously depend from the allowable claims and further describe features of the present invention.

In view of the above amendments and remarks, the Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims 1- 40, is neither disclosed nor suggested by the references of record. Accordingly, the Applicant respectfully requests allowance of all claims.